2. Claims 53, and 55 have been rejected under 35 U.S.C. 103 as being unpatentable over Strandberg (U.S. 3,207,125) in view of Official Notice. The Examiner stated that Strandberg teaches essentially all the elements of the claimed invention except the recitation that the solvent is an organic solvent. The Examiner further stated that the limitation of the organic solvent does not overcome Strandberg since the liquid treatment taught in Strandberg is capable of applying a variety of liquid treatments including an organic solvent.

Applicants traverse the rejection and submit a prima facie case of obviousness has not been made. Strandberg does not teach or suggest a solvent applying means partially submerged in solvent as the Applicants claim. In fact, Strandberg teaches away from a solvent applying means that is partially submerged in a solvent by disclosing immersion roll (6) is totally immersed in liquid (4). Total immersion of the textile web in Strandberg is important because of the relationship between conductivity of probes (38), (39), and the conductivity of the textile web. (See Col. 4, lines 23-40; Col. 5 lines 44-54 and Figs. 1-2).

The Applicants, on the other hand, claim partial submersion of the solvent applying means to apply a measured amount of solvent to the strip. (See page 27, lines 6-10; page 28, lines 1-6; Figures 2-7A). Application of a measured amount of solvent or measured absorption of solvent into the fabric and/or fabric roll is used in the Applicants' invention to achieve "saturated functional equilibrium" of the fabric and/or fabric roll for purposes of imparting efficient cleaning ability to the fabric.(See page 17, lines 6-17).

It is well settled that prior art must be considered in its entirety, including portions that

would lead away from the claimed invention. The fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In Strandberg, the claimed device of having a solvent applying means partially submerged in solvent to apply a measured amount of solvent to a fabric strip is neither taught nor suggested. Strandberg teaches away from partial submersion as the Applicants claim by using total immersion as previously described.

The Applicants contend that since the cited reference does not teach or suggest what the Applicants claim, a prima facie case of obviousness has not been made. Reconsideration and withdrawal of the rejection under §103 (a) is respectfully requested.

3. Claim 54 has been rejected under 35 U.S.C. 103 as being unpatentable over Strandberg in Zimmer (U.S. 4,538,541). The Examiner stated it would have been obvious to substitute the immersion roll in Strandberg with the combination of the application roller and supply roller taught in Zimmer. Applicants traverse the rejection and submit a prima facie case of obviousness has not been made.

Applicants repeat the same argument made previously with respect to Strandberg and add the following remarks. The modifications of substituting the immersion roll in Strandberg with the combination of the application roller and supply roller in Zimmer would change the principle of operation of Strandberg. Strandberg is directed at an apparatus that uses conductivity of a textile and a soaking liquid in a tank to control the amount of liquid added to the textile. Strandberg teaches the function of the disclosed circuit is to enable adjustment of a variable resistor (15) in

order to correct the measuring circuit for conductivity of liquid (4) in the tank (5). (See Col. 3, lines 20-25; Col. 2, lines 17-21). The addition of the application roller in Zimmer that is meant to apply liquid outside a tank changes Strandberg's operation because the circuits disclosed in Strandberg are meant to monitor conductivity in the tank, not outside the tank on an application roller. Strandberg would require a totally different circuit with the addition of an application roller, which would change the principle of Strandberg's operation than originally disclosed. It is well settled that when a the modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

Regarding Zimmer, this reference is silent as to teaching a solvent applying means having a solvent supply roller, a rotating roller, and an application roller as the Applicants claim. The Applicants supply roller is partially submerged in solvent. The application roller causes solvent to transfer from the solvent supply roller to said application roller which then applies solvent to the strip of cleaning fabric. The Applicants' claimed rotating roller is adjacent to the application roller, and the strip of cleaning fabric is place between and adjacent to the rotating roller and the application roller for the application roller to apply a measured amount of solvent in contact with said strip of cleaning fabric. Zimmer teaches no such structure as the Applicants' claim. Reconsideration and withdrawal of the rejections is respectfully requested.

4. Claim 56 is rejected under 35 U.S.C. §103 as being unpatentable over Strandberg in view of Wenger (U.S. 3,548,784). The Examiner stated it would have been obvious to modify the

Strandberg apparatus to provide a squeezing roller juxtaposed with a dipping roller having its lower portion submerged in solvent/liquid as taught by Wenger. Applicants traverse the rejection and submit a prima facie case of obvious has not been made.

Applicants repeat the previous arguments made above and add the following remarks. Strandberg cannot function as intended with the squeezer as disclosed in Wenger. The measuring circuit of the invention in Strandberg consists of a pair of spaced detector electrodes including a grounded squeeze roll (9) and detector roll (11). (See, Col. 3, lines 8-10) If the squeeze roll in Strandberg was now modified to be in the solvent tank as disclosed in Wegner, the measuring circuit in Strandberg would short circuit since the squeeze roller can not be grounded in liquid because the liquid in the tank would conduct electricity from the circuit. Since the principle of operation of the prior art being modified would change, the teachings of the references are not sufficient to render the claims prima facie obvious. Reconsideration and withdrawal of the rejections is respectfully requested.

5. Claims 51-52 are rejected under 35 U.S.C. §112, first paragraph as containing subject matter not described in the specification to reasonably convey a pair of rollers adjustable in temperature. Applicants contend this subject matter can be found in the specification on page 25 lines 16-22. The specification supports a pair of rollers hotter than room temperature, at about ambient temperature, or less than ambient temperature. Thus, the rollers are adjustable in temperature. Reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

In light of the above Amendments and Remarks, it is respectfully submitted that the application is in condition for allowance, which action is respectfully requested. If any issues remain, the Examiner is kindly invited to contact the undersigned at the telephone number below. The Examiner's favorable consideration is greatly appreciated.

The Commissioner is hereby authorized to charge any fees, which may be required for this amendment, or credit any overpayment, to Deposit Account No. 13-4500, Order No. 0140-4126US1.

In the event that an extension of time is required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 0140-4126US1. A DUPLICATE COPY OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: December 6, 2002

By: _____
Keith J. McWha
Registration No. 44,235

Corresponding Address
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154
(212) 415-8727 (direct)
(212) 751-6849 (Fax)

APPENDIX A MARKED UP VERSION OF AMENDED CLAIM

Please amend claims 53, and 54 as follows:

53. (Amended) A device for preparing a soaked cleaning fabric for use in cleaning a printing press comprising:

means for mounting a first supply roll having a strip of cleaning fabric wound around a shaft;

solvent applying means for applying a low volatility, organic compound solvent which does not readily evaporate at ambient pressure and temperature to said strip of cleaning fabric for forming a soaked strip of cleaning fabric, such that said solvent applying means is partially submerged in said solvent to apply a measured amount of said solvent to said strip;

means for forming a second supply roll comprising said soaked strip of cleaning fabric; and

an excess solvent removing means interposed between said solvent applying means and said second supply roll for removing excess solvent from said strip of cleaning fabric and obtaining said strip of cleaning fabric to functional equilibrium with said solvent.

54. (Amended) The device in claim 53, wherein said solvent applying means further comprises a solvent supply roller, a rotating roller, and an application roller such that said supply roller is partially submerged in solvent, and rotation of said solvent supply roller and said application roller causes solvent to transfer from said solvent supply roller to said application roller which then applies solvent to said strip of cleaning fabric such that said rotating roller is adjacent to said application roller and said strip of cleaning fabric is place between and adjacent to said rotating roller and said application roller for the application roller to apply a measured amount of solvent in contact with said strip of cleaning fabric .